

### **REMARKS**

Applicants thank the Examiner for the thorough consideration given the present application.

Claims 1, 4-13, 15-24, 35, 36, 38 and 40 are now present in this application. Claim 1 is independent.

Claim 1 has been amended, and claims 37 and 39 have been canceled. Reconsideration of this application, as amended, is respectfully requested.

### **Request for Withdrawal of Finality of Office Action**

Applicants respectfully submit that the Examiner's second Office Action was improperly made final, and respectfully requests that the finality of the second Office Action be reconsidered and withdrawn.

In the Office Action of July 20, 2010, the Examiner made no rejection of claim 14 based on a lack of written description. Claim 1 recited that the nozzle diameter was between 0.01 microns, and claim 14, which depends from claim 1, recited that the droplet diameter was 15 microns or less. The Examiner now rejects these features as lacking written description. The rejection is not necessitated by amendment since claim 14 recited this combination.

Withdrawal of the finality of the previous Office Action, entry of the present amendment and an Office Action on the merits of the claims, are respectfully requested.

### **Reasons for Entry of Amendments**

At the outset, it is respectfully requested that this Amendment be entered into the Official File in view of the fact that the amendments to the claims automatically place the application in condition for allowance.

In the alternative, if the Examiner does not agree that this application is in condition for allowance, it is respectfully requested that this Amendment be entered for the purpose of appeal. This Amendment reduces the issues on appeal by placing the claims in compliance with 35 U.S.C. § 112, 1st Paragraph, and by canceling allowable claim 37 and incorporating the limitations thereof into independent claim 1. This Amendment was not presented at an earlier date in view of the fact that Applicants did not fully appreciate the Examiner's position until the Final Office Action was reviewed.

**Rejection Under 35 U.S.C. § 112, 1<sup>st</sup> Paragraph**

Claims 1, 4-24 and 35-40 stand rejected under 35 U.S.C. § 112, 1<sup>st</sup> Paragraph. This rejection is respectfully traversed.

“In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.” *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). A disclosure provides adequate written description if it conveys with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *See id.* One shows possession “by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

Here, the present application conveys with reasonable clarity to those skilled in the art that the inventors were in possession of the invention. The Examiner will note that the amendment simply combines features which were optional in the method as originally filed. These were not features of separate embodiments disclosed as not being useful in combination. Specifically, the Examiner states that there is no written description of the combination of a nozzle having an inside diameter is 0.01  $\mu\text{m}$  to 8  $\mu\text{m}$  and a diameter of the ejected droplet being 15  $\mu\text{m}$  or less. The droplet diameter is discussed at several places in the specification, including page 8, lines 20-21 and page 10, lines 6-7 and 18-21. When discussing the nozzle used to form the droplets, page 21 states that “[i]n the method of producing a three dimensional structure according to the present invention, an inside diameter of the tip of the nozzle is preferably 0.01  $\mu\text{m}$  or more in terms of manufacture.” The description refers to the structures built by the droplets which are disclosed as having a diameter of 15  $\mu\text{m}$  or less. Page 21, lines 16-18 provides a written description of the inside diameter being 0.01  $\mu\text{m}$  to 8  $\mu\text{m}$ . These parameters refer to the single invention disclosed in the specification. Applicants do not seek to combine elements of two embodiments that are not disclosed as being used together.

The Examiner refers to the Examples provided in the specification but these examples are non-limiting and do not detract from the fact that the description of the invention includes the parameters of a nozzle having an inside diameter is 0.01  $\mu\text{m}$  to 8  $\mu\text{m}$  and a diameter of the ejected droplet being 15  $\mu\text{m}$  or less. The specification provides a clear written description of the

claimed subject matter. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

### **Rejections under 35 U.S.C. § 103**

Claims 1, 4, 6, 8-16, 23, 24 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Danforth in view of Sachs et al. and Gratson for the reasons set forth in paragraph 3 of the Office Action. Further, claims 7, 14-22 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Danforth in view of Sachs et al., Gratson and Hayes for the reasons set forth in paragraph 4 of the Office Action and claim 36 stands under 35 U.S.C. § 103(a) as being unpatentable over Danforth in view of Sachs et al., Gratson and either Uchiyama or Hertz for the reasons set forth in paragraph 5 of the Office Action. These rejections are respectfully traversed.

Complete discussions of the Examiner's rejections are set forth in the Office Action, and are not being repeated here.

With regard to the rejection of claim 1, while not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicants respectfully submit that independent claim 1 has been amended to include the limitations of objected-to allowable claim 37, thereby automatically placing independent claim 1 into condition for allowance, along with dependent claims 4-13, 15-24, 35, 36 and 38-40.

### **Allowable Subject Matter**

The Examiner states that claims 5 and 37-40 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112, 1st Paragraph.

Applicants thank the Examiner for the early indication of allowable subject matter in this application. Applicants present arguments to overcome the rejection under 35 U.S.C. § 112, 1<sup>st</sup> Paragraph. As set forth above, the limitations of objected-to claim 37 have been added into independent claim 1, and therefore independent claim 1 should be in condition for allowance. Also, claims 4-13, 15-24, 35, 36 and 38-40 depend, either directly or indirectly, from independent claim 1, and are therefore allowable based on their dependence from claim 1 which is believed to be allowable.

**Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Christopher J. McDonald, Registration No. 41,533, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated:           **MAY 03 2011**          

Respectfully submitted,

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**USPTO #43,575**

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